

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 1001.1719101	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>July 23, 2010</u> Signature <u>Kathleen L. Boekley</u> Typed or printed name <u>Kathleen L. Boekley</u>		Application Number 10/717,775	Filed November 20, 2003
		First Named Inventor John A. Griego	
		Art Unit 3738	Examiner Christopher D. Prone
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>41,376</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		Signature <u>J. Scot Wickhem</u> Typed or printed name <u>612.677.9050</u> Telephone number <u>July 23, 2010</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re:	John A. Griego et al.	Confirmation No.:	8387
Serial No.:	10/717,775	Examiner:	Christopher D. Prone
Filing Date:	November 20, 2003	Group Art Unit:	3738
Docket No.:	1001.1719101	Customer No.:	28075
For:	SELF-ORIENTING POLYPECTOMY SNARE DEVICE		

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL CONFERENCE BRIEF**

**CERTIFICATE FOR ELECTRONIC TRANSMISSION:**

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 23rd day of July 2010.

By \_\_\_\_\_

  
Kathleen L. Bockley

Dear Sir:

Applicants submit that the rejections set forth in the Final Office Action mailed January 28, 2010 and sustained in the Advisory Action mailed April 13, 2010 contain at least the following clear errors and/or omissions of one or more essential elements needed for a prima facie rejection.

Claims 1, 37, 39, 40 and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kline in U.S. Patent No. 5,376,094 in view of Savage in U.S. Patent No. 6,530,899. This rejection is a clear error.

Each of independent claims 1, 37, and 39 recites a shaft, a snare loop, and a swivel that connects the snare loop to the shaft.

The Final Office Action indicated that “Kline does not disclose a swivel connection between the shaft and the snare loop.” However, the Final Office Action went on to state that “Savage teaches the use of a swivel connection between two elements ... [and that] [i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the crimp connection of Kline with the bearing swivel connection comprising a swivel housing and bearings as taught by Savage in order to allow easy rotation without kinking of the cables.” We believe that this replacement is a clear error.

Kline specifies that the connection between the cable 12 and the snare loop 20 either a crimp connector 58, as shown, or another means such as soldering or brazing. In addition, Kline

specifies that “[i]t is desirable that this connection be capable of conducting electricity from cable 12 to snare loop 20.” Column 5, lines 63-65. It is clear from this passage and the sentences leading up to it that Kline envisions a fixed or static connection between the cable 12 and the snare loop 20 so as to allow for reliable and consistent conduction of electricity. If the connection was altered so that direct electrical contact between the cable 12 and snare loop 20 was lost, even for a relatively short or intermittent period, the overall function of the system could be rendered unsatisfactory for its intended purpose.

The substitution suggested in the Final Office Action and maintained in the Advisory Action amounts to replacing the static connection in Kline with a “moveable” connection as set forth in Savage. Should such a replacement be made, the moveable connection would likely result in at least an intermittent loss of direct electrical contact between the cable 12 and the snare loop 20 at some point when the structures swivel. For example, in order for the structures to be able to freely swivel with respect to one another, some small amount of gap or space must be present between the structures. This gap would almost certainly lead to a loss (albeit intermittent, but none-the-less still relevant) in the electrical connection between the cable 12 and the snare loop 20. Additionally, if there was a loss in electrical conductivity between the cable 12 and the snare loop 20 due to the use of a swivel, electrical current passing along the cable 12 could seek to pass along another pathway, which could result in a short circuit or other potentially dangerous situation. Thus, a potential loss in electrical conductive would undermine the function of the Kline device and render it unsatisfactory for its intended purpose. See: MPEP §2143.01-IV. For at least this reason, the substitution set forth in the Final Office Action and sustained in the Advisory Action is a clear error.

Other structural features also distinguish the claimed invention from the cited art. For example, independent claim 1 recites that at least the first end of the swivel is disposed within the sheath when the shaft is in the second (e.g., where the snare loop substantially extends distally out of the distal end region of the sheath) position. Similarly, independent claim 37 recites that the swivel is disposed within the sheath when the shaft is in the second (e.g., where the snare loop extends distally out of the distal end region of the sheath) position. Likewise, independent claim 39 recites that at least the first end of the swivel is disposed within the sheath when the shaft is in the second (where the snare loop substantially extends distally out of the distal end region of the sheath) position.

It should be noted that each of these independent claims not only recites that the shaft is

movable between first and second positions, but each claim specifically sets forth the position of the swivel when the shaft is in the second position. In other words, when the shaft is in the second position (e.g., when the snare loop extends distally out of the distal end region of the sheath) the [first] end of the swivel is disposed within the sheath.

Kline does not appear to teach or suggest the claimed invention. Instead, Kline only appears to disclose a crimp connection 58 between the snare loop 20 and the distal end of the cable 12 and, as seen in each of the Figures, the crimp connection is disposed distally out from the distal end of the sheath 14 when the snare loop is extended distally out of the distal end of the sheath 14.

The Advisory Action indicated that “[i]t is clear from the figures [of Kline] that before deployment of the loop, the swivel would be contained within the sheath and when a substantial amount of the loop extends out of the sheath the user could control its advancement to retain the swivel member within the sheath.” It appears as though the Advisory Action is suggesting that some “intermediate” amount of shifting is possible for the cable 12 such that the crimp connection 58 of Kline *could* remain within the sheath 14 when *a portion* of the snare loop 20 was extended out from the sheath 14. While it may be possible for the crimp connection 58 to remain within the sheath 12 when a *small* amount of the snare loop 20 is extended out of the sheath 14, nothing in Kline appears to teach or suggest that the crimp connection 58 would still remain within the sheath 12 when the snare loop 20 substantially extends distally out of the distal end region of the sheath 12.

Furthermore, the claimed structural arrangement of the swivel relative to the sheath may be desirable for a number of reasons. For example, page 4, lines 7-11 of the instant application recite:

However, it may be desirable for swivel 24 to be set back proximally a distance so that even when snare loop 22 is configured for severing a polyp (i.e., when snare loop 22 extends distally from sheath 12), swivel 24 still remains within sheath 12. This embodiment may help reduce the possibility that swivel 24 may catch or become “hung up” on sheath 12 when snare loop 22 is proximally retracted.

Thus, the claimed structural arrangement of the swivel relative to the sheath may help reduce the possibility that the swivel may catch on the sheath.

Savage does not overcome the shortcomings of Kline. For example, even if the connection of Savage was substituted for the crimp connector 58 of Kline, the resultant

combination would still fail to teach or suggest the claimed structural arrangement of a swivel and a sheath. Indeed, nothing in the cited art appears to identify the problem solved by the claimed invention or suggest the desirability of correcting it. Additionally, nothing in the art references appears to provide any motivation to altering the references in order to provide a structure that corrects this problem. Because of this, one of ordinary skill in the art would not be motivated to combine the cited art references and then alter the resultant combination (e.g., alter the combination so as to meet the claimed invention) in order to solve a problem not appreciated in the art.

Based on the forgoing, Applicants respectfully submit that the rejection of claims 1, 37, 39, 40 and 43 is a clear error and should be withdrawn in due course.

Claims 7 and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kline in view of Savage as applied to claims 1, 37, 39, 40 and 43 above, and further in view of Fleury Jr. in U.S. Patent No. 4,326,530. For the reasons set forth above, Applicants respectfully submit that claims 1 and 39 are patentable over Kline and Savage. Fleury, Jr. does not overcome the shortcomings of the cited art. Consequently, Applicants respectfully submit that claims 1 and 39 are patentable over the combination of Kline, Savage, and Fleury, Jr., to the extent that such a combination is even possible. Because claims 7 and 42 depend from patentable claims 1 and 39, respectively, Applicants respectfully submit that these claims are also patentable over the cited art.

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

John A. Griego et al.

By their attorney,

Date: \_\_\_\_\_

July 23, 2010

  
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